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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/436,598	11/09/1999	ANDREAS LENNIGER	GR-97-P-1593	6870

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EXAMINER

GRAYBILL, DAVID E

ART UNIT	PAPER NUMBER
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2827

DATE MAILED: 07/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/436,598	LENNIGER ET AL.	
	Examiner	Art Unit	
	David E Graybill	2827	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: _____

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5-17-02 has been entered.

The declarations under 37 CFR 1.132 filed 7-02-01 and 5-17-02 are insufficient to overcome the rejection of claims 1-7 based upon 35 U.S.C. 102 as set forth in the previous office action because they fail to set forth facts. In particular, the declarations present only vague and general statements in broad terms unsupported by proof or objective evidence; hence, they essentially amount to mere conjecture. *Ex parte Gray*, 10 USPQ2d 1922 (Bd. Pat. App. & Inter. 1989) (statement in publication dismissing the "preliminary identification of a human b - NGF - like molecule" in the prior art, even if considered to be an expert opinion, was inadequate to overcome the rejection based on that prior art because there was no factual evidence supporting the statement); *In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992) (declarations of seven persons skilled in the art offering opinion evidence praising the merits

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of the claimed invention were found to have little value because of a lack of factual support); Ex parte George, 21 USPQ2d 1058 (Bd. Pat. App. & Inter. 1991) (conclusory statements that results were "unexpected," unsupported by objective factual evidence, were considered but were not found to be of substantial evidentiary value).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

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Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 and 3-6 are rejected under 35 U.S.C. 102(a) as being anticipated by applicant's admitted prior art.

At page 1, line 10 to page 2, line 13; and page 6, line 11 to page 7, line 14, applicant admits as conventional a product comprising a substrate 4 disposed in a plastic housing 2 defining a housing base of the housing, the substrate containing a ceramic plate 5 having a top side and a bottom side with a top metallization layer 6 disposed on the top side and a bottom metallization layer 7 disposed on the bottom side, the top metallization layer facing an interior of the housing being patterned in order to form interconnects and equipped for and receiving semiconductor components 10; terminal elements 11 for providing external terminals in housing element openings; and wires 8 bonded to the terminal elements and to the components, wherein the elements run approximately parallel to the housing base in the interior of the housing, the housing includes a frame 9 and a cover, the elements are disposed in the frame, and

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the substrate is covered with a potting compound (illustrated in FIG 1).

Although applicant's admitted prior art does not appear to explicitly teach the process limitation, "said terminal elements press-fitted into said connecting element openings," the product of applicant's admitted prior art inherently possesses the characteristics imparted by this process limitation.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art as applied to claim 1 supra, and further in combination with Nakamura (7153906).

Although applicant's admitted prior art teaches a product wherein the housing has an inner side, applicant's admitted prior art does not appear to explicitly teach the process limitation, "terminal elements press-fitted into said connecting element openings," or the limitation, "said terminal elements have lugs which bear on said inner side for fixing said terminal elements in position." Nevertheless, Nakamura teaches terminal elements 10 press-fitted into connecting element openings 4d having lugs 10b which bear on a housing inner side for fixing the terminal elements in position. Moreover, it would have been obvious to combine the invention of Nakamura with the invention

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of applicant's admitted prior art because it would provide terminal elements.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admitted prior art as applied to claim 6, and further in combination with Leukel (FR2535898).

Applicant's admitted prior art does not appear to explicitly teach a product wherein the elements have lugs which bear on the inner side for fixing the elements in position, and the compound is formed of a soft potting layer and a hard potting layer disposed on the soft layer.

Nonetheless, at page 6, lines 11-21, Leukel teaches a product wherein elements 10, 12 have lugs which bear on the inner side of housing 16 for fixing the elements in position, and the compound is formed of a soft potting layer 15 and a hard potting layer 16 disposed on the soft layer. Moreover, it would have been obvious to combine the invention of Leukel with the invention of applicant's admitted prior art because it would increase package reliability.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of applicant's admitted prior art and Nakamura as applied to claim 6, and further in combination with Leukel (FR2535898).

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The combination of applicant's admitted prior art and Nakamura does not appear to explicitly teach that the compound is formed of a soft potting layer and a hard potting layer disposed on the soft layer.

Nonetheless, at page 6, lines 11-21, Leukel teaches a compound formed of a soft potting layer 15 and a hard potting layer 16 disposed on the soft layer. Moreover, it would have been obvious to combine the invention of Leukel with the invention of the applied prior art because it would increase package reliability.

Applicant's remarks filed 3-13-2 have been fully considered and are addressed supra and infra.

Applicant contends that the applied prior art does not teach the process limitation, "said terminal elements press-fitted into said connecting element openings." This contention is respectfully deemed to be unpersuasive because the applied prior art is not relied on in the rejection for this teaching. To further clarify, it is noted that rejection under 35 U.S.C. 102 and/or 35 U.S.C. 103 is indicated where prior art discloses a product that appears to be either identical with or only slightly different from the product claimed in a product by process claim. Further, applicant can be required, to prove that the prior art product does not necessarily or inherently

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possess characteristics of the claimed product. Whether the rejection is based on inherency under 35 U.S.C. 102, on prima facie obviousness under 35 U.S.C. 103, jointly or alternatively, the burden of proof is the same. When, as here, there is reason to believe that the functional limitation asserted to be critical for establishing novelty in the claimed subject matter is an inherent characteristic of the prior art, the Office possesses authority to require applicant to prove that subject matter shown to be in the prior art does not possess the characteristic relied on. See *In re Fitzgerald, Sanders, and Bagheri*, 205 USPQ 594 (CCPA 1980).

Applicant also alleges that the scope of the instant invention is limited to a process wherein, "the terminal elements do not have to be encapsulated by injection molding of plastic." This allegation is respectfully traversed because the product claims are not so limited, and the prior art is not applied to the rejection for this teaching.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first

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action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not applied to the rejection is considered pertinent to applicant's disclosure. It is cited primarily to show inventions similar to the instant invention.

Any telephone inquiry of a general nature or relating to the status (MPEP 203.08) of this application or proceeding should be directed to Group 2800 Customer Service whose telephone number is 703-306-3329.

Any telephone inquiry concerning this communication or earlier communications from the examiner should be directed to David E. Graybill at (703) 308-2947. Regular office hours: Monday through Friday, 8:30 a.m. to 6:00 p.m.

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The fax phone number for group 2800 is 703/3087724.



David E. Graybill
Primary Examiner
Art Unit 2827

D.G.
5-Jun-02